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09/621,830	07/24/2000	Louis Brown Abrams	D.N.7167	6580

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/621,830

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 18-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/03 - 05/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 26, 2003, has been entered.

### ***Response to Amendment***

2. Applicant's amendments filed November 26, 2003, February 9, 2004, and April 16, 2004, have been entered. Claims 5-17 are cancelled and new claims 47-53. Thus, the currently pending claims are 1-4 and 18-53.

3. With applicant's filing of an RCE, the case was petitioned to be withdrawn from issue. Said petition was granted on December 2, 2003. Thus, prosecution is reopened and the previously indicated allowable subject matter is hereby withdrawn in view of the following new rejections.

### ***Specification***

4. The amendment filed January 8, 2003, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

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introduce new matter into the disclosure of the invention. Specifically, the sentence added at the end of the paragraph on page 6, line 10, is considered new matter: "As shown in FIG. 3, a fringe material 50 can be applied to peripheral edges of the flocked release sheet 1 or substrate 15 during this manufacturing process." First, it is noted that the drawings as originally filed do not identify "fringe material 50." Secondly, the specification as originally filed never discusses any fringe material. Thirdly, it is not clear from FIG. 3 or the amended FIG 3 (filed February 25, 2003) that the item identified as "50" is indeed a "fringe material." While FIG. 3 *may* show a "fringe material," without any recitation in the specification to fringe, FIG. 3 can also be interpreted as an exaggerated view of the edges of flocked surface of the transfer 1. As such, the amendment to the specification reciting a "fringe material" is considered new matter. Fourthly, even if it is conceded that FIG. 3 as originally filed is sufficient support for "fringe material 50," the specification lacks support for the embodiment that said fringe material is applied to the peripheral edges of substrate 15. Therefore, said amendment to the specification is considered new matter. Applicant is required to cancel the new matter in the reply to this Office Action.

5. The amendment filed February 9, 2004, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. Specifically, said amendment is drawn to two separate embodiments for the permanent adhesive, one being a hot melt adhesive (i.e., thermoplastic) and the other being a thermosetting adhesive. While the specification as originally filed employed the term "hot melt film" or "hot melt sheet," these recitations are not sufficient support for a disclosure to a thermoplastic hot melt adhesive, since said terms were employed throughout the specification to describe a thermosetting adhesive. Note applicant's

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discussion of prior art flock transfers at page 2, 2<sup>nd</sup> paragraph of *Background of the Invention* and page 4-5, 2<sup>nd</sup> paragraph of *Detailed Description of the Invention*. Throughout the discussion of the prior art flock transfers, the term “hot melt adhesive” is employed to describe the permanent adhesive layer. As applicant correctly notes in the Remarks section of the Amendment filed February 9, 2004, the definition of a “hot melt adhesive” is limited to thermoplastic materials. Now note applicant’s discussion of the present invention at page 3, 2<sup>nd</sup> paragraph of *Brief Summary of the Invention* and page 5, 1<sup>st</sup> paragraph – page 7, 2<sup>nd</sup> paragraph. Throughout this discussion, applicant employs the terms “hot melt film” or “hot melt sheet,” not “hot melt adhesive.” Additionally, said “hot melt film” and “hot melt sheet” are taught as thermosetting adhesives. Hence, it is understood that said film or sheet is a preformed thermosetting adhesive that is subjected to heat to activate (i.e., hot melt film or sheet). Furthermore, note applicant’s discussion of the difference between the prior art and the present invention at page 7, last paragraph. This discussion consistently employs the term “hot melt adhesive” for describing the prior art while stating that that one aspect of the present invention is the absence of said “hot melt adhesive.” Hence, applicant’s invention is based upon the substitution of a thermosetting adhesive for the prior art combination of a binder adhesive and a thermoplastic hot melt adhesive (page 3, 1<sup>st</sup> paragraph, page 5, lines 12-14, and page 7, last paragraph). Therefore, applicant’s amendment, which changes the scope of the specification to describe two embodiments wherein either a thermoplastic adhesive or a thermosetting adhesive is employed as the permanent adhesive, is considered new matter. Further support for this assertion can be found in applicant’s own filing of a continuation-in-part application (09/735,721), which states the following:

[0005] In my co-pending application, I have described the usage of a thermoset film in lieu of the bond and powder for adhesion, which film, when subject to heat, adheres to

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the substrate, functions as an inherence for the flock. This current invention adds further enhancements to this process, by allowing the application and usage of a thermoplastic film, for adherence of the flock transfer.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Drawings***

6. The drawing of FIG. 3, filed February 25, 2003, is not accepted by the Examiner in that the amended drawing contains new matter as discussed above.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4 and 18-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 29 of copending Application No. 10/670,091 (US 2004/0058120). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

9. Claim 24 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 24 is objected to for being dependent upon claim 27. Since claim 26, from which claim 27 depends, already limits the thermosetting adhesive to being in the form of a film prior to contact with the free surface of the flock, the recitation of claim 24, wherein the thermosetting film is preformed before application to the flock and substrate, is not further limiting.

### ***Claim Rejections - 35 USC § 112***

10. Claims 40, 42, 44, and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

11. Claim 40 contains new matter in that the phrase “comprising a fringe material extending outwardly from peripheral edges of the substrate” is not supported by the specification as originally filed. Claim 42 is similarly rejected.

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12. Claims 44 and 46 contain new matter because the specification does not clearly support the limitation that “at least most” of an adjacent surface of the transfer is in direct physical contact with the thermosetting film.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 1 is indefinite because the location of the thermosetting film is unclear with respect to the flock transfer structure. Is said thermosetting film adjacent to the free ends of the flock or is it located on an opposite surface? Claim 18 is similarly rejected.

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-4, 18-39, 41, and 43-53 are rejected under 35 USC 103(a) as being unpatentable over US 4,687,527 issued to Higashiguchi in view of US 4,810,549 issued to Abrams et al.

Higashiguchi discloses a method of making flock patterns and the flock transfers employed (abstract). Specifically, Higashiguchi teaches paper release sheet 20 which is solidly flocked with fibers 18. As is conventional in the art, said flock is adhered to the paper release



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sheet by an adhesive having weaker adhesion than the permanent adhesive that bonds the flock to a final substrate (col. 1, lines 24-26). The free ends of the flock are adhered to a permanent adhesive 16 coated onto a fabric surface 12 in a desired pattern (col. 5, lines 2-17). Said adhesive 16 is a thermosetting adhesive (col. 4, lines 19-35 and 44-52 and col. 5, lines 39-42). Said thermosetting adhesive may be a polyurethane resin (col. 4, lines 53-59).

Thus, Higashiguchi teaches the invention of claims 1-4, 18-20, 22, 23, 43, and 48 with the exception that the flock is arranged on the release sheet in a desired pattern. While Higashiguchi employs a solidly flocked transfer sheet and patterns the permanent adhesive to create the flock pattern, it would have been readily obvious to one of ordinary skill in the art to reverse the process. For example, an alternative method of producing a flock transfer is well known in that. Said method includes producing the design in the flock transfer sheet, rather than in the permanent adhesive as taught by Higashiguchi. Note Abrams, col. 2, lines 34-43. Thus, it would have been obvious to one of ordinary skill in the art to create the flock pattern on the transfer sheet rather than with the patterned permanent adhesive taught by Higashiguchi. Such a modification would enable less flock waste on the flock transfer. Therefore, claims 1-4, 18-20, 22, 23, 43, and 48 are rejected.

Regarding claims 24, 26-33, 35, 36, 38, 45, 46, 47, 49, and 50, which limit the thermosetting adhesive to be in a solid film form before application to the free end of the flock, said claims are also obvious over the cited prior art. Said limitations reflect the method of making the flock transfer assembly. As such, said limitations are not necessarily given patentable weight at this time since the claims are examined on the structure of the final product claimed. It is believed that the final product of the prior art has the same structural features of

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the present invention as described in the preceding paragraph. Therefore, claims 24, 26-33, 35, 36, 38, 45, 46, 47, 49 and 50 are also rejected.

Claims 21 and 37 are similarly rejected in that the method step of pre-cutting the adhesive sheet is not necessarily given patentable weight at this time.

Regarding claims 25 and 34, before the thermosetting adhesive is fully cured, said adhesive is not fully cross-linked. Thus, during manufacture at the point of contact between the adhesive and the flock before being cured, the claim limitation is met by the prior art.

With respect to claims 44 and 46, it is argued that the limitation that at least most of the surface of the transfer is in direct contact with the thermosetting adhesive is met by the fact that the amount of surface contact is dependent upon the desired pattern. As such, it would have been readily obvious to one skilled in the art to maximize the surface contact in order to produce less waste of the flock transfer. Therefore, claims 44 and 46 are also rejected.

Regarding claims 39, 41, and 51-53, while the cited prior art fails to teach a rubber substrate or a polyester thermosetting adhesive, it would have been obvious to one of ordinary skill in the art to substitute a rubber substrate for the fabric substrate or a polyester thermosetting resin for the polyurethane thermosetting resin since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 39, 41, and 51-53 are also rejected.

18. Claims 40 and 42 are rejected under 35 USC 103(a) as being unpatentable over the cited Higashiguchi and Abrams references and in further view of "*When is a mouse pad really a rug?*" by R. Landwehr.

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While Higashiguchi and Abrams fail to explicitly teach the use of fringe on the edge of the flock transfer, said fringe is known in the art of flocked articles. For example, the Landwehr article teaches a flocked mouse pad having a design of an oriental rug, including having fringed edges. Therefore, it would have been obvious to one skilled in the art to employ fringe edges for decorative purposes. Thus, claims 40 and 42 are rejected as being obvious over the cited prior art.

### *Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cj  
October 1, 2005

  
CHERYL A. JUSKA  
PRIMARY EXAMINER